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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,247	11/17/2003	Farah D. Morton	9241.03	5210

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EXAMINER

HEWITT, JAMES M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,247

Applicant(s)

MORTON, FARAH D.

Examiner

James M Hewitt

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/17/03, 3/29/04, 9/24/04 and 9/17/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 16-18, 20-28 and 31-32 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/17/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Applications

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

As, the patent sought to be reissued by this application is involved in litigation, any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

Due to the related litigation status of this application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED DURING THE PROSECUTION OF THIS APPLICATION.

Claims 16-18 and 20-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which

was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

With respect to claim 16, the limitation requiring the pad to extend beyond the base panel has been omitted and thus provides the "broadening aspect" in claim 16. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 16, the limitation "leaving a gap between said second side wall and said other end wall" and the limitation requiring the second side wall to be a partial side wall have been omitted and thus provide the "broadening aspect" in claim 16. In the original application, these limitations were presented in the amendment filed 7/23/01 to obviate the rejection of claim 8 (35 U.S.C. 103(a) rejection in view of Lerner) in the office action of 4/23/01. Also note page 3 lines 4-12 of Applicant's remarks in the 7/23/01 response.

With respect to claim 18 (and claims 20-28), the limitation requiring the pad to extend beyond the base panel has been omitted and thus provides the "broadening aspect" in claim 18. In the original application, this limitation was presented in the

Art Unit: 3679

amendment filed 2/5/01 to obviate the rejection of claim 1 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 18 (and claims 20-28), the limitation requiring the pad to fit on top of said envelope (cover) has been omitted and thus provides the "broadening aspect" in claim 18. In the original application, this limitation was presented in the amendment filed 2/5/01 to obviate the rejection of claim 8 (35 U.S.C. 103(a) rejection in view of Antosko and Schrieber) in the office action of 10/6/00.

With respect to claim 18 (and claims 20-28), the limitation "leaving a gap between said second side wall and said other end wall" and the limitation requiring the second side wall to be a partial side wall have been omitted and thus provide the "broadening aspect" in claim 18. In the original application, these limitations were presented in the amendment filed 7/23/01 to obviate the rejection of claim 8 (35 U.S.C. 103(a) rejection in view of Lerner) in the office action of 4/23/01. Also note page 3 lines 4-12 of Applicant's remarks in the 7/23/01 response.

Claim Objections

Claims 23, 26, 31, and 32 are objected to because of the following informalities:

In claim 23 line 2, "said cover extension" lacks antecedent basis. The cover extension is recited in claim 19, and claim 23 does not depend from claim 19, directly or indirectly.

In claim 26 line 2, "said inside surfaces" lacks antecedent basis. Should the claim depend from claim 25 and not from claim 18?

In claim 31 line 8, "the left edge" lacks antecedent basis. It is apparent that the phrase "the left edge of" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 31 is rejected under 35 U.S.C. 102(b) as anticipated by Lerner (US 3,336,608).

As is clear from the Figures, Lerner discloses the portable infant bed as claimed in detail in claim 31. Lerner's bed includes a pad (20) that is placed on the base panel between the side panels, and it should be understood that this pad abuts each of the side panels and each of the end panels, or in other words is dimensioned in accord with the base panel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18, 21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antosko (US 5,115,524) in view of Linge (US 5,675,853).

With respect to claims 16 and 18, as is clear from the Figures, Antosko discloses a portable infant bed (10) as claimed in detail in claims 16 and 18, with the exception of the claimed fabric cover covering the unit. Antosko's infant bed is made from a flat sheet of foldable material such as cardboard. Linge teaches a portable infant bed which includes a removable, washable, form fitting fabric cover (38) that is used to protect the underlying bed. In view of Linge's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Antosko with a removable, form fitting, fabric cover in order to protect the bed from being soiled.

With respect to claim 17, Antosko fails to teach that the base panel has a square shape, and rather teaches a base panel having a rectangular shape. It would have been an obvious matter of design choice to modify Antosko's base panel with a square shape since Applicant has not disclosed that employing such a shape offers any significant advantage and it is apparent that Antosko's rectangular-shaped base panel performs equally as well.

With respect to claim 21, wherein at least one handle (23) is provided on the cover.

With respect to claim 26, the Examiner takes official notice of the use of pockets on an inner wall of an infant bed in order to provide storage means for various items.

With respect to claim 27, the Examiner takes official notice of providing slots in an end wall of an infant bed for receiving a securement belt to secure the infant.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Antosko and Linge as applied to claim 18 above, and further in view of Butler, III (US 5,551,108).

Antosko and Linge teach all the limitations of claim 25 except for the provision of pockets on the outside surfaces of the cover. Butler, III teaches a portable baby cushion that can have a plurality of pockets disposed on the outside of the cushion (Figure 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate pockets on the walls of Antosko's crib as taught by Butler, III in order to provide storage means for various items.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Antosko and Linge as applied to claim 18 above, and further in view of Dishart (US 3,269,621).

Antosko and Linge teach all the limitations of claim 28 except that a plurality of openings are provided on the back of the base panel for receiving suction cups. Dishart teaches a baby cradle-like carrier having openings in the base for receiving suction cups. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Antosko with openings on the back of his base panel for receiving suction cups in order to allow securement of the bed.

Claims 16-18, 21, 26-27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner (US 3,336,608) in view of Linge (US 5,675,853).

With respect to claims 16, 18 and 32, as is clear from the Figures, Lerner discloses a portable infant bed as claimed in detail in claims 16, 18 and 32, with the exception of the claimed fabric cover covering the unit. Lerner's infant bed is covered with a plastic cover (30). Linge teaches a portable infant bed which includes a removable, washable, form fitting fabric cover (38) that is used to protect the underlying bed. In view of Linge's teaching, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lerner with a removable, fabric cover since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 17, Lerner fails to teach that the base panel has a square shape, and rather teaches a base panel having a rectangular shape. It would have been an obvious matter of design choice to modify Lerner's base panel with a square shape since Applicant has not disclosed that employing such a shape offers any significant advantage and it is apparent that Lerner's rectangular-shaped base panel performs equally as well.

With respect to claim 21, wherein at least one handle (50) is provided on the cover.

With respect to claim 26, the Examiner takes official notice of the use of pockets on an inner wall of an infant bed in order to provide storage means for various items.

With respect to claim 27, the Examiner takes official notice of providing slots in an end wall of an infant bed for receiving a securement belt to secure the infant.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner and Linge as applied to claim 18 above, and further in view of Butler, III (US 5,551,108).

Lerner and Linge teach all the limitations of claim 25 except for the provision of pockets on the outside surfaces of the cover. Butler, III teaches a portable baby cushion that can have a plurality of pockets disposed on the outside of the cushion (Figure 8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate pockets on the walls of Lerner's crib as taught by Butler, III in order to provide storage means for various items.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner and Linge as applied to claim 18 above, and further in view of Dishart (US 3,269,621).

Lerner and Linge teach all the limitations of claim 28 except that a plurality of openings are provided on the back of the base panel for receiving suction cups. Dishart teaches a baby cradle-like carrier having openings in the base for receiving suction cups. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lerner with openings on the back of his base panel for receiving suction cups in order to allow securement of the bed.

Allowable Subject Matter

Claims 1-15 and 29-30 are allowed.

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

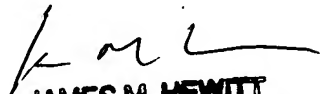
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JAMES M. HEWITT
PRIMARY EXAMINER